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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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23373	7590	08/26/2005		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER PATTERSON, MARIE D	
			ART UNIT 3728	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/019,669
Filing Date: May 13, 2002
Appellant(s): DARBY, H. DARREL

MAILED
AUG 26 2005
Group 3700

Brian K. Shelton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/3/05.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief contains a statement that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 32, 41, and 42 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,491,909	DARBY	2-1996
5,370,133	DARBY	12-1994
5,329,705	GRIM	7-1994
5,799,414	KELLERMAN	9-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. Claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darby (5491909) in view of Darby (5370133) and Grim (5329705).

Darby '909 shows a shoe comprising an outsole (16), an upper (14), an insole assembly (18), and a shank (22) substantially as claimed except for the sole having a circumferential counter portion and the exact layered insole. Darby '133 teaches providing an outsole with a circumferential counter portion (shown as 16A in figure 1) which clearly shows an being of a height which would prevent shifting of all of the sole/insole layers, since it is shown in figures 1 and 7 as being taller than the topmost layer of the insole/sole. Grim teaches providing an insole with a plurality of different layers (52, 64, and 56) which are separably removable and are "capable of being rearranged in a different order" (due to the layers being completely detachable from one another) and one having a removable area (68) for use in a medical shoe. It would have been obvious to provide the outsole with a counter portion as taught by Darby '133

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and to provide an insole having a plurality of different separable layers as taught by Grim in the shoe of Darby '909 to provide greater stability to the outsole/upper construction and to increase the cushioning and medial benefits of the insole construction taught by Grim.

2. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 41, and 42 above, and further in view of Kellerman (5799414).

Darby '909 as modified above shows an insole assembly substantially as claimed except for skiving the edges of the oval area. Kellerman teaches skiving/chamfering the edges of an opening (see column 5 lines 27-46). It would have been obvious to skive/chamfer the edges of the opening as taught by Kellerman in the insole assembly of Darby '909 as modified above to provide a smooth transition and to make the removable portion easier to remove.

Allowable Subject Matter

3. Claims 3, 6, 9, 12-30, and 35-40 are allowed.

(11) Response to Argument

In response to applicants' arguments directed towards the lip of Darby '133, the lip of Darby '133 shown as 16A is clearly around the entire periphery of the shoe as shown in figures 1 and 6 in that the lip is continuous and formed integral with the heel portion numbered 34 which clearly is above all sole layers.

In response to applicants' argument that the air bladder 64 of Grim is part of an inner sole assembly, this does not negate the fact that layer 64 is separably removable. The layer 64 is clearly shown and disclosed as being secured in the footwear by hook and loop fasteners which are removable fastening means (as shown at 54 and 98 in figure 3) and therefore the layer is "separably removable".

In response to applicants' argument that the lip of Darby would not prevent the upper resilient layer 66 from shifting if the layers of Grim were arranged in a different order, the layer 66 has hook and loop fastening means which are clearly capable of being attached to the hook and loop fastening elements at 54 on element 20 at 56 and the bladder layer 64 could be placed above layer 66 loosely. Also, since the rim/lip of Darby '133 clearly extends up over the sides and heel portions of the foot (see highlighted portion in the attached marked up copy of figure 1 of Darby '133) and therefore inherently and clearly would be high enough to prevent shifting of the layers.

In response to applicants' arguments directed towards a stacking order with the layer 20 of Grim being located above all of the other layers, there is no requirement of such an order in the claims, the claims merely require that the layers are capable of being

stacked in different orders. Merely reversing the order of the top two layers (52 and 64) meets this claim limitation.

In response to applicants' argument that Grim only teaches one stacked order of the insole layers, the claims do not require any specific order. The claims merely require that the layers are "separably removable" and that they are "capable of being rearranged". The layers of Grim are separably removable (by the hook and loop fastening materials) and are "capable of being rearranged" (because the layers are not permanently attached to one another they are capable of being rearranged). There is no requirement in the claims for the layers to be rearranged, only that they are "capable of being rearranged" and the layers of Grim have that capability.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, Darby '705 and '133 and Grim are all directed towards medical boots. Darby '133 clearly teaches the use of a lip/circumferential counter (shown in the attached highlighted figure) for increase

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support and stability as discussed in column 5. Grim clearly teaches many benefits and provides clear motivation for using insole layers including a bladder and a layer with removable sections for medical reasons as recited in column 1 lines 15-42 and column 2 lines 11-23.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Marie Patterson
Primary Examiner
Art Unit 3728

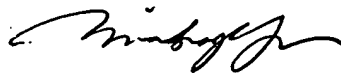
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August 24, 2005

Conferees



Ted Kavanaugh



Mickey Yu

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

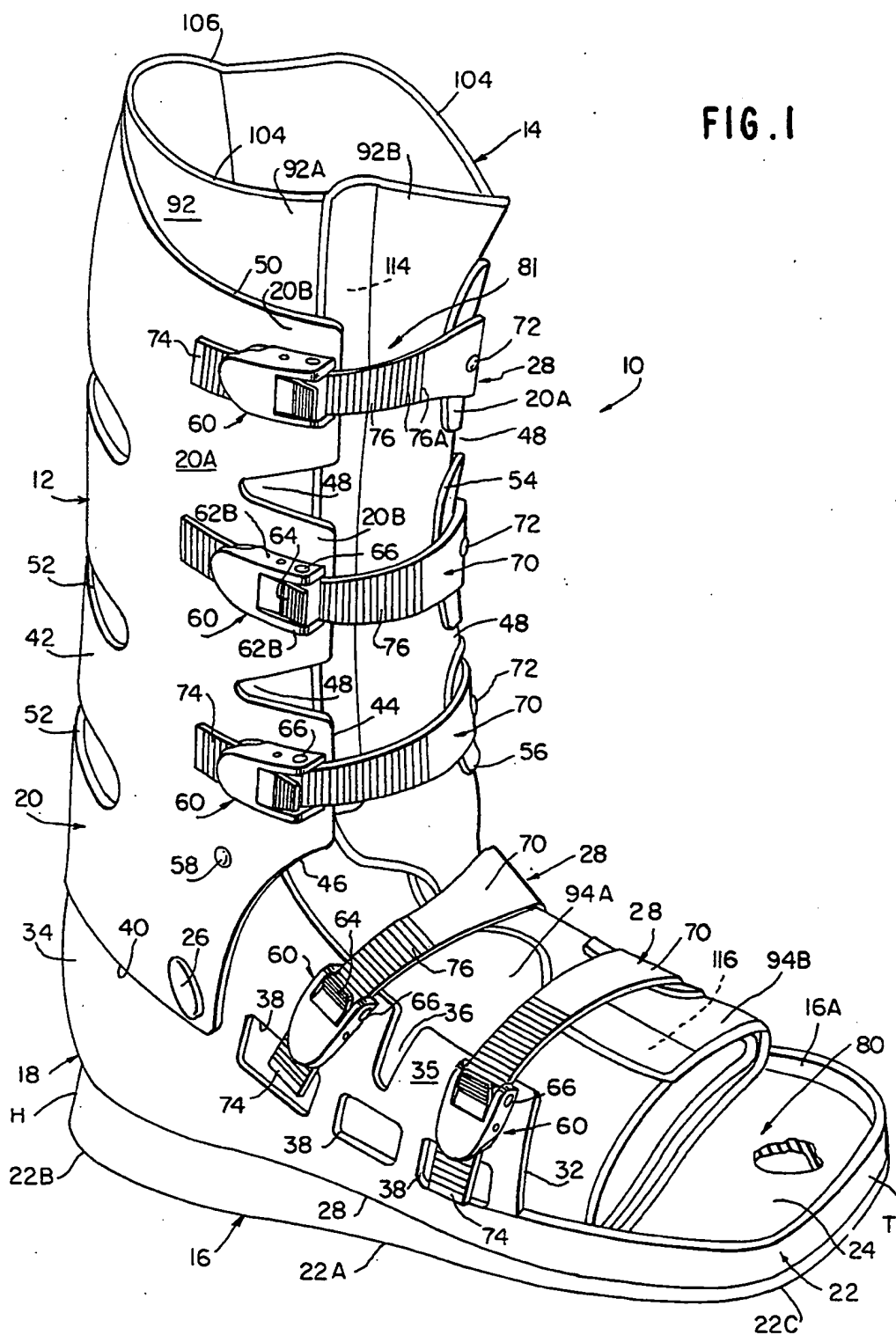


FIG. 1

